

### REMARKS/ARGUMENTS

Reconsideration and allowance of the present application based on the following remarks are respectfully requested.

Upon entry of the above amendments, claims 18-23, as amended, will be pending.

The inadvertent error in claim 18 is corrected. The claim objection should, therefore, be withdrawn.

Reconsideration and withdrawal of the rejection of claims 18-23, as unpatentable over Craswell *et al* US 4,302,343 (hereafter US-343), is respectfully requested for at least the following reasons.

The disclosure of US-343 is not at all concerned with a lubricant composition which can solve the problem of avoiding formation of stable emulsions when the lubricant composition is mixed with water in an air compressor. To the contrary, the lubricant compositions of US-343 are designed to remain stable to "heat, air, and water" (*see, e.g.*, column 1, lines 59-64).

Accordingly, it is considered to be highly unexpected, in view of the disclosure of US-343, that selection of a particular double end-capped polyalkylene glycol in combination with a polyol ester would solve the problem which confronted the present Applicants.

That the selection of the particular double end-capped polyalkylene glycol would be able to provide unstable emulsions is not only contrary to the disclosure of US-343 but is also unexpected in view of the stable emulsions prepared using other of the polyalkylene glycols described in US-343. In this regard, the Examiner's attention is directed to the specification of the subject application, specifically, the Examples and Comparative Examples.

In Table 2 on page 5, the results obtained by combining the polyol ester with a single end-capped polyalkylene glycol show that demulsibility was not achieved, rather, the compositions formed stable emulsions when mixed with water. This is contrasted with the results reported in Table 1 on page 4 which demonstrate the absence of an emulsion phase over a wide range of conditions within the scope of the invention.

Accordingly, it is respectfully submitted that the broad disclosure of US-343 of polyether glycols for use in combination with a polyol ester would not have led the practitioner of ordinary skill in the art to the embodiments of the present invention which are the subject of claims 18-23. For example, US-343 makes no distinction between non-end

capped, single end capped or double end capped polyether polyols, such as shown by the formula in column 2, lines 7-24 and column 2, line 67 to column 3, line 21. Thus, in Examples 1-3, non-end capped polypropylene glycol was used as the polyether polyol. In Examples 4-7, single end capped compounds were used.

Accordingly, one skilled in the art having the disclosure of US-343, would not have expected that the lubricated air compressors containing the lubricant composition with a double end capped polyalkylene glycol, would have been capable of providing the desired destabilization of the emulsions formed upon addition of water. Therefore, notwithstanding the disclosure of US-343, the present Applicants have made a truly non-obvious invention.

Applicants also respectfully disagree that it would have been *prima facie* obvious to add an antifoaming agent to the lubricant composition of US-343. The disclosure that "effective amounts of additives" may be included in the final lubricant composition is not a suggestion that any additive, whatsoever, could or should be added. The exemplified additives, antioxidants, corrosion inhibitors, metal deactivators, lubricity additives, extreme pressure additives, dispersants, detergents do not suggest antifoaming agents. The mere inclusion of the catch-all phrase "or such other additives as may be required" (column 3, lines 52-55) does not present evidence that antifoaming agents "may be required." For example, as noted on page 5 of the specification, the compositions of the comparative examples using a single end capped polyether polyol had a lesser tendency to foam than the compositions with a double end capped polyalkylene glycol. There is nothing in the disclosure of US-343 which would suggest that an antifoaming agent would not only be useful for controlling foaming but would be capable of doing so, without compromising the demulsibility results (*see, e.g.*, the present specification on page 5, lines 11-14).


Accordingly, for this additional reason, the subject matter of dependent claim 21 is independently patentable over US-343.

Therefore, all objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned attorney for Applicants at the telephone number indicated below in order to expeditiously resolve any remaining issues.

Respectfully submitted,

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